



UNITED STATES PATENT AND TRADEMARK OFFICE

len
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,387	07/09/2002	Jon David Garlett	BUR920000198	5830
45831	7590	05/17/2007		
DILLON & YUDELL LLP 8911 N. CAPITAL OF TEXAS HWY., SUITE 2110 AUSTIN, TX 78759			EXAMINER TSE, YOUNG TOI	
			ART UNIT 2611	PAPER NUMBER
			MAIL DATE 05/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/064,387

Applicant(s)

GARLETT ET AL.

Examiner

YOUNG T. TSE

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-8,10,11,13,15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-8,10,11,13,15,19,20 and 22-26 is/are rejected.
- 7) ☒ Claim(s) 17,18 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed February 23, 2007 have been fully considered but they are not persuasive. Regarding the rejection of claims 2-8 and 10-16 rejected under 35 U.S.U. § 112, first paragraph, the amendment of the claims has not overcome the rejection. See paragraph 8 of the last Office Action and further detail below.

Drawings

2. The drawings were received on February 23, 2007. These drawings are acceptable.

3. The drawings are objected to because the proposed drawing correction of the numerals "52" and "54" are integrated in a single activator "51" as shown in the Replacement Sheet of Fig. 4 raises the issue of new matter because neither the original specification nor the original claims of the instant application supports the changes of Fig. 4. Further, the numeral "66" shown in Fig. 6 should be changed to "67" because the multiplexer 66 shown in Fig. 5 has been changed to 67. In general, any gate or logic circuit needs at least two inputs in order to perform the operation of the gate or logic circuit. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The

figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: in the amendment to paragraph [0025] filed February 23, 2007, the newly added term "In one embodiment, the random digital sequence generator 52 and the activate circuit 54 are included within a single component referred to as the activator 51" raises the issue of new matter because neither the original figures nor the original claims support the changes in the specification of the instant application. In paragraph [0035], line 6 and paragraph [0039], line 6, both "multiplexer 66" should be "multiplexer 67". Appropriate correction is required.

Claim Objections

5. Claims 3, 5-8, 11, 13, 15 and 17-26 are objected to because of the following informalities:

In line 2 of both claims 3 and 11, "at least one of a time delay" should be either "at least one time delay" or "at least one of the time delays".

In claim 5 (line 2), claim 6 (line 1), claim 7 (line 3), claim 13 (line 2) and claim 15 (line 3), the word "number" should be "sequence".

In line 4 of both claims 7 and 15, "a test mode of operation" should be "the test mode of operation" for clarity.

In claim 8 (line 9) and claim 21 (line 7), the word "also" should be deleted.

In claim 11, line 2, "operating the" should be "operating of the".

In claim 15, line 2, "detecting presence of" should be "detecting the presence of".

In claim 17, line 2, the term "(sequence generator)" should be deleted.

In claim 18, line 2 and line 2-3, "a pre-set sequence" and "as test data" should be "the pre-set sequence" and "as the test data", respectively.

In claim 22, line 4, "a test output" should be "the test data".

In claim 23, line 5, "the test output" should be "the test data".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 2, 3, 6-8, 10, 11, 13 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The configuration of claims 2, 3, 6-8, 10, 11, 13 and 15 does not correspond to the disclosure of Figs. 4 and 5 as mentioned in the specification.

According to the present invention, Fig. 4 shows the detail embodiment of the self-test system 48 of Fig. 3 comprising at least a random digital sequence generator-linear feedback shift register 52, an activate circuit 54 and a multiplexer 60. Fig. 5 shows the detail embodiment of the active circuit 54 of Fig. 4 comprising at least a decoder or decode gating circuit 80, two delay circuits 83 and 85, and a time adjust system 56.

Regarding claims 2 and 10, the self-test system comprising a time adjust system 56 and an activator. However, the specification fails to discuss the difference between the activator and an active circuit 54 (see claim 8) in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make

and/or use the invention. Further, as shown in Fig. 5, the time adjust system 54 is within the activate circuit 54.

Regarding claims 5-7, 13 and 15, the claims contain subject matter that the activator includes a random digital number generator 52 was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As shown in Fig. 4, the random digital number generator 52 is not part of the activate circuit 54.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 8, 19, 20 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8 (line 10), claim 19 (line 3), claim 20 (line 3) and claim 22 (line 3), the phrases "the pre-set sequence of digital bits", "the activate circuit", "the data window" and "said output" all lack antecedent basis.

The dependent claims 23-26 are rejected to because they are depended upon claim 22.

Allowable Subject Matter

10. Claims 17, 18 and 21 would be allowable if rewritten or amended to overcome the objection(s) set forth in this Office action.

11. Claims 19, 20 and 22-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

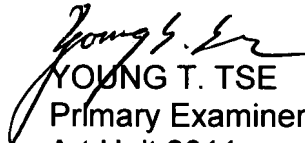
12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **YOUNG T. TSE** whose telephone number is (571) 272-3051. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


YOUNG T. TSE
Primary Examiner
Art Unit 2611